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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,603	12/28/2000	Katherine E. Hayes	XER 2 0346	6753

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Albert P. Sharpe, III, Esq.
Fay, Sharpe, Fagan, Minnich & McKee, LLP
7th Floor
1100 Superior Avenue
Cleveland, OH 44114-2518

EXAMINER

KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/750,603	Applicant(s) HAYES ET AL.	
	Examiner Stefano Karmis	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 30 May 2006.

Status of Claims

2. Claims 1-23 are previously presented. Claims 1-23 are pending.

Response to Arguments

3. Applicant's arguments filed 30 May 2006 have been fully considered but they are not persuasive as discussed below. Therefore claims 1-23 stand rejected as previously stated, and Applicant's request for allowance is respectfully declined.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18, 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1-18, 20 and 23 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as stated in the previous office action mailed 24 April 2006.

Applicant's argument that the phrase "arbitrarily" is definite under 35 U.S.C. 112, second paragraph, is not persuasive. It would not be obvious to one of ordinary skill in the art to determine qualifications for an arbitrarily long list of aspects. Applicant states in the remarks that one of ordinary skill in the art would understand that an "arbitrarily long list would have a length depending on choice or discretion based on convenient selection or choice" (see page 5). However, it is not clear in the claims, whose choice is determining the arbitrarily long list and it is also not clear whether such a choice could comprise, just picking a number or choosing to use an equation. Therefore it would not be obvious to anyone of ordinary skill in the art how an arbitrary long list of aspects is determined and therefore claims 1-18, 20 and 23 remain rejected under 35 U.S.C. 112, second paragraph.

Furthermore, if the Examiner was to interpret "arbitrarily" as Applicant's asserts in a dictionary definition for "arbitrary" which states "depending on choice or discretion; specifically: determinable by decisions of a judge or tribunal rather than defined by statute" (see page 4); then claims 1-18, 20 and 23 would stand rejected under 35 U.S.C. 101 because they would fail to produce a concrete result.

Therefore, Applicant's arguments regarding the rejections of claims 1-18, 20 and 23 stand rejected under 35 U.S.C. 112, second paragraph are not persuasive.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7, 16, 17 and 19-23 rejected under 35 U.S.C. 102(e) as being anticipated by Maruta et al. (hereinafter Maruta) U.S. Patent 6,516,157.

Claims 1-7, 16, 17 and 19-23 stand rejected under 35 U.S.C. 102(e) as being anticipated by Maruta et al. (hereinafter Maruta) U.S. Patent 6,516,157 as stated in the previous office action mailed 24 April 2006.

7. Regarding claims 1-23, Applicant's argument that Maruta fails to teach a configurable billing system is not persuasive. In response to applicant's arguments for claim 1, the recitation configurable billing system has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15

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(CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore there are no limitations in claim 1 in which configuring a billing system is performed. Applicant's remarks regarding configuring a billing system refer to passages in the specification (see top of page 3) rather than the claims. While claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Claims 6, 16, 19 and 20-22 are substantially similar to claim 1 and remain rejected for similar reasons as stated above.

Regarding claims 1-23, Applicant argues that Maruta fails to teach a coded billing strategy as depicted in certain parts of the specification and figures (see bottom of page 3). While claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Therefore Maruta discloses a "coded billing strategy" as interpreted by the Examiner at least at (column 9, lines 2055 and column 10, lines 43-62 and column 12, lines 12-53). Therefore Applicant's argument that Maruta fails to teach a coded billing strategy is not persuasive. The phrase "machine readable script" and "maker module" and "billing module" and "meter data" are rejected using the same reasoning as discussed above for coded billing strategy with respect to claims 6, 16, 19-23.

Applicant's remarks concerning claims 2-5, 7 and 17 are not persuasive. Therefore, these claims stand rejected as stated in the previous office action and set forth below.

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Claim 2, the coded billing strategy further comprises information regarding a format in which information regarding the aspect of interest will be communicated to the billing system by the machine (column 11, lines 51-57).

Claim 3, wherein each meter in the list of meters is described as a function of at least one of the listed aspects of interest (column 10, lines 23-34).

Claim 4, wherein the coded billing strategy comprises information associated with the listed meters, the information describing the function of the meters (column 10, lines 43-53).

Claims 5 and 7, wherein the plurality of meters are instantiated in memory, by the billing system, according to the coded billing strategy (column 10, lines 14-21).

Claim 17, wherein the marker module is operative to deliver the billing strategy to the billing system (column 10, lines 43-63).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 8-15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruta et al. (hereinafter Maruta) U.S. Patent 6,516,157.

10. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Other than the arguments, for claim 6, Applicant provides no other arguments why claims 8-15 and 18 would not be obvious. Therefore, Applicant's arguments regarding claims 8-15 and 18 are not persuasive and these claims remain rejected.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Respectfully Submitted
Stefano Karmis
27 July 2006

